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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,678	04/10/2001	Tadayuki Suzuki	0425-0821P	3254

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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 08/25/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/744,678

Applicant(s)

SUZUKI ET AL.

Examiner

Alton N. Pryor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1,2,6-9,13-20 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,2,6-9,13-15,17,19 and 27-29 is/are rejected.
- 7) ☐ Claim(s) 16,18,20,30 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6,7,27,28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6,27 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: related to what object is the composition being applied to.

The term "using" in claims 7,28 is a relative term which renders the claim indefinite. The term "using" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. What is meant by the term?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1,8,17** are rejected under 35 U.S.C. 102(b) as being anticipated by **JP 54020010; 2/15/79**. **JP '010** teaches a composition comprising **glucose or fructose** plus **sorbitan fatty acid ester**. See abstract. In a claim to a composition the intended used has no patentable significance.

Claims **1,15,17,29** are rejected under 35 U.S.C. 102(b) as being anticipated by **JP 07291856; 11/7/95**. **JP '856** teaches a composition comprising **ethanol or isopropanol** plus 0.1 % **sorbitan fatty acid ester**. See abstract.

Claims **1,14,17** are rejected under 35 U.S.C. 102(b) as being anticipated by **JP 55083707; 6/24/80**. **JP '707** teaches a composition comprising **calcium salt** plus **sorbitan fatty acid ester**. See abstract.

Claims **1,13,17** are rejected under 35 U.S.C. 102(b) as being anticipated by **JP 59189185; 10/26/84**. **JP '185** teaches a composition comprising **semicarbazide** plus **sorbitan fatty acid ester**. See abstract.

Claims **1,6,7,9,17,27,28** are rejected under 35 U.S.C. 102(b) as being anticipated by **JP 02209801; 8/21/90**. **JP '801** teaches a composition comprising **brassinolides** plus **sorbitan fatty acid ester**. **JP '801** teaches that the composition is applied to plants to simulate rooting, initial plant growth, etc. See abstract. It is inherent that the application of the composition to the plants would keep the plant fresh.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,19,29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **JP '801** as applied to claims **1,9,17** above. See **JP 801** 35 USC 102(b) rejection above. **JP '801** teaches all that is recited in claims 2,19,29 except for the composition comprising 0.0001 to 0.1 wt % sorbitan fatty acid ester and the instant ratio of sorbitan fatty acid ester to **brassinolides**. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the optimum amounts and ratios of ingredients. One would have been motivated to do this in order to make the most effective composition for **regulating plant growth**.

Claims 2,19,29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **JP '185** as applied to claims **1,13,17** above. See **JP 185** 35 USC 102(b) rejection above. **JP '185** teaches all that is recited in claims 2,19,29 except for the composition comprising 0.0001 to 0.1 wt % sorbitan fatty acid ester and the instant ratio of sorbitan fatty acid ester to **semicarbazide**. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the optimum amounts and ratios of ingredients. One would have been motivated to do this in order to make the most stable semicarbazide composition.

Claims 2,19,29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **JP '707** as applied to claims **1,14,17** above. See **JP 707** 35 USC 102(b) rejection above. **JP '707** teaches all that is recited in claims 2,19,29 except for the composition comprising 0.0001 to 0.1 wt % sorbitan fatty acid ester and the instant ratio of sorbitan fatty acid ester to **copper salt**. It would have been obvious to one having ordinary skill

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in the art at the time the invention was made to determine the optimum amounts and ratios of ingredients. One would have been motivated to do this in order to make the most effective composition for **treating skin**.

Claims 2,19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **JP '856** as applied to claims **1,15,17** above. See **JP 856** 35 USC 102(b) rejection above. **JP '856** teaches all that is recited in claims 2,19 except for the composition comprising the instant ratio of sorbitan fatty acid ester to **ethanol or isopropanol**. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the optimum ratios of ingredients. One would have been motivated to do this in order to make the most effective composition for **treating skin**.

Claims 2,19,29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **JP '010** as applied to claims **1,8,17** above. See **JP 010** 35 USC 102(b) rejection above. **JP '010** teaches all that is recited in claims 2,19,29 except for the composition comprising 0.0001 to 0.1 wt % sorbitan fatty acid ester and the instant ratio of sorbitan fatty acid ester to **glucose**. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the optimum amounts and ratios of ingredients. One would have been motivated to do this in order to make the most effective composition.

***Claim Objection / Allowable Subject Matter***

Claim 16,18,20,30,31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach or

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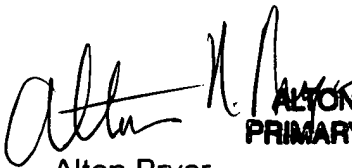
suggest component (A) having glycoside linkage or amide linkage to sugar or sugar alcohol. The prior art does not suggest the composition of claim 20 comprising gibberellin. The elected composition is allowable. Based on Applicant's arguments in paper no. 16, Examiner withdraws the election requirement.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 703 308-4691. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

  
**ALTON N. PRYOR**  
**PRIMARY EXAMINER**  
Alton Pryor  
Patent Examiner  
AU 1616